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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,639	05/09/2001	William E. Adams IV	010629	3602

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EXAMINER

SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 02/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/851,639

Applicant(s)

ADAMS, WILLIAM E.

Examiner

Jon A Szumny

Art Unit

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

## Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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This is the <sup>fourth</sup>~~first~~ office action for application number 09/851,639, Suction Holder for Razor, filed on May 9, 2001.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent number 5,961,087 to Lee.

Lee '087 discloses a holder and flag (figure 2) comprising a suction cup (10) having cup and neck portions (figure 1), wherein the neck has a transverse bore (figure 2) having a multi-sided cross section, and a flag (100,101) having a display portion (101) attached to a pole (figure 1), a portion of the pole having a multi-sided cross section complementary to that of the bore and fitted within the bore so it can be rotated therein so that in each position every side of the portion of the pole is opposite a side of the bore.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rendall '996 in view of U.S. Patent number 4,506,408 to Brown.

Regarding claims 1, 3 and 6, Rendall '996 reveals a holder (figure 2) comprising a magnetic device having a magnet (38) and a neck with at least one bore comprising a single bore passing therethrough, and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. However, Rendall '996 fails to specifically teach the magnetic device to be a suction cup having a cup portion and a neck containing at least one bore.

Figure 7 of Rendall '996 divulges a holder comprising a rubber suction cup (103) having a cup portion and a neck with at least one bore and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the at least one bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the magnetic device with a suction cup so as to reduce weight and manufacturing costs, in addition to providing for an alternate mounting means.

Moreover, Rendall '996 fails to specifically teach the cross sections of the at least one bore and two ends of the split ring to be multi-sided cross-sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the ends of the split ring and the at least one bore of Rendall '996 to be complementary hexagonal cross-sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the split ring to be more securely maintained in a desired position.

Regarding claim 2, Rendall '996 in view of Brown '408 fail to *specifically* teach the cross-sections to be square. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the cross-sections to have any number of sides, including four so as to be square shaped cross-sections, in order to meet the specific design needs of an operator.

With respect to claim 4, Rendall '996 in view of Brown '408 fail to *specifically* teach the cross-sections to be octagonal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have increased the number of sides

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of the cross-sections so as to be octagonal cross-sections since doing so would be seen as simply a duplication of parts. See *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Alternatively, regarding claims 1, 3 and 7, Rendall '996 reveals a holder (figure 7) comprising a rubber suction cup (103) having a cup portion and a neck with at least one bore comprising a pair of bores on a common axis wherein each bore extends from an outer surface of the neck toward a center of the neck so that a web separates the two bores, and a split ring having two ends each fitted within the bore and each having a cross section complementary to that of the bore such that the split ring can be rotated within the at least one bore from a first position to a second position such that in each position every side of the end of the split ring is opposite a side of the at least one bore. However, Rendall '996 fails to specifically teach the cross sections of the at least one bore and two ends of the split ring to be multi-sided cross-sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the ends of the split ring and the at least one bore of Rendall '996 to be complementary hexagonal cross-sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second

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position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the split ring to be more securely maintained in a desired position.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rendall '996 in view of Brown '408, and further in view of Adams '865.

Rendall '996 in view of Brown '408 divulge the previous invention failing to specifically teach the suction cup to specifically be made of soft vinyl or the ring to comprise polypropylene or polycarbonate. However, Adams '865 teaches a holder having a soft vinyl suction cup (column 4, lines 10-11) and a polycarbonate ring (column 3, lines 64-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the suction cup and ring of Rendall '996 in view of Brown '408 of soft vinyl and polycarbonate, respectively, as in Adams '865 so as to provide for improved gripping strength of the suction cup, and to provide for a resilient but sturdy ring.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams '356 in view of Brown '408.

Adams '356 discloses a holder (figure 3) comprising a suction cup (26) having cup and neck portions, the neck containing a transverse bore, and a J-hook (18) having two ends, a portion thereof, having a head adjacent thereof, being fitted within the bore so that the hook can be rotated within the bore from a first position to a second position such that in each position every side of the portion of the hook is opposite a side of the bore. However, Adams '356 fails to specifically teach the cross sections of the bore and

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the portion of the hooked fitted within the bore to be complementary multi-sided cross sections.

Brown '408 divulges a holder (figure 9) comprising a member (72) rotatable within a bore wherein the member and the bore have complementary hexagonal cross-sections such that the member can be rotated within the bore from a first position to a second position such that in each position substantially every side of the member is opposite a side of the bore so as to effect variable positioning between the member and the bore. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the cross sections of the portion of the J-hook being fitted within the transverse bore and the transverse bore of Adams '356 to be square cross sections as in Brown '408 (such that when the ring is rotated within the bore from a first to a second position, *inherently* every side of the end of the ring would be opposite a side of the at least one bore) so as to provide for a more sturdy holder by allowing the J-hook to be more securely maintained in a desired position.

### ***Response to Arguments***

Applicant's arguments filed January 3, 2003 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner will still attempt to address all remaining arguments with respect to claims 1-10.



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On the bottom of page 3 and top of page 4 of the remarks, the applicant contends "But, there is no teaching or motivation in Rendall or the other suction cup art that a ring should be more securely maintained in a desired position." This comes as no surprise to the Examiner. If there were such a teaching in Rendall, why would the Examiner have relied on a secondary reference for that teaching? Similarly, for instance, in claim 5, the Examiner relied on Adams '865 for teaching that a suction cup could be constructed of a soft vinyl and that a ring could be constructed from a polycarbonate (both of which were not taught in Rendell), yet that applicant did not contend that there was "no teaching or motivation" for such a combination. Therefore, it is clear that the primary reference is not necessarily required to first teach or suggest a feature in order for that feature to be incorporated into the primary reference via a combination of references.

In addition, the Examiner has not utilized the applicant's teaching as motivation to modify the references. Reasons and motivations have been provided for all combinations.

Regarding the rejection of claim 11 under 35 U.S.C. 102(e), the applicant asserts that because Lee '087 refers to numeral 100 as a "flagpole," refers to numeral 80 as a "rotor," and because, supposedly, element 80 "in Figure 3 has a diameter that is very close to its length (both are about 15mm)... .. element 80 is not 'a long slender object' and does not meet Webster's definition of a pole... .. one skilled in the art would not regard the rotor 80 as a pole."

To begin, the applicant has not provided the exact location in which Lee '087 supposedly recites that the diameter and length of element 80 are "about 15mm." Furthermore, with reference to figure 2 (the Examiner attached a copy of figure 2 in the previous office action indicating the section considered to be the "pole"), how could the applicant possibly allege that the diameter of the pole as indicated by the Examiner could be close to its length? Such is just not true. Clearly, the pole as indicated by the Examiner could indeed be considered a "long, slender object" by an ordinary artisan, and hence could be considered a "pole" with the display portion attached thereto.

Moreover, on the bottom of page 4, the applicant asserts, "the Examiner denies that he concluded that the bore in Lee is transverse..." Such is not true. The Examiner denied reciting the statement "an *axial bore from the top* is in fact 'transverse.'" Nevertheless, Lee '087 teaches a suction cup with a cup portion and a neck having a *transverse bore with a multi-sided cross section*. However, the applicant alleges "element fits in bore 72 which is not transverse." The applicant is not providing a *reason* why the bore *is not* transverse. The Examiner again will provide a reason why the bore *is* transverse. As defined in "Merriam-Websters Collegiate Dictionary, 10<sup>th</sup> Edition", "transverse" is defined as "lying or being across", and "across" is defined as "from one side to the other side", so the bore as indicated by the Examiner is in fact "transverse" to the neck.

Continuing, the applicant contends the bore is circular, not multi-sided. The Examiner disagrees. Near numeral 71, the bore is certainly multi-sided.

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The applicant contends the bore is in the rotor 80. The Examiner disagrees. The bore (with reference to figure 2) is clearly not part of element 80, but is indeed part of the neck of the suction cup.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dudley et al. '488 discloses a holder including rotating members having complementary multi-sided cross-sections.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



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February 3, 2003



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